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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,073	04/19/2000	Adam Coyle	06042-0145	3055

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EXAMINER

COLBERT, ELLA

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/552,073

Applicant(s)

COYLE ET AL.

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 26-157 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 26-157 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 26-157 are pending in this communication filed 12/03/04 entered as Response To Election/Restriction Requirement. Claims 1-25 have been previously canceled and claims 26-157 have been previously added. Applicant's election with traverse of Group I, claims 26-84 and 118-129 in the reply of 12/03/03 is acknowledged.

#### ***Arguments With Traverse***

2. The traversal is on the ground(s) that claims 85-129 have now been re-cast as Group II and claims 48-57 were moved to Group I.

Issue no. 1: Applicants' argue: The inventions of both Groups I and II have been characterized as Class 705 (AUTOMATED ELECTRICAL FINANCIAL OR BUSINESS PRACTICE OR MANAGEMENT ARRANGEMENT), subclasses 39 and 40. Group I inventions are shown in the USPTO classification manual as subclass 39, "Finance, Including funds transfer or credit transaction," while the Group II invention is shown in the manual as subclass 40, "Finance, Including funds transfer or credit transaction, bill distribution or payment." In other words, the classification of Groups I and II are so close that the only difference is a single level within the USPTO classification manual, two and three levels deep and what does "bill distribution or payment" have to do with a "cash card"?

#### ***Response to Arguments With Traverse***

3. Applicants' arguments have been considered and are addressed as set forth here below.

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Response: A "cash card" is a method of payment. It is acknowledged that subclasses 39 and 40 are close to each other in the manual of classification. However, Group I, claims 26-84 and 118-129 are drawn to maintaining an account at a financial institution and sweeping the funds and an account sweep control module which are not present in the other groupings of claims and Group II, claims 85-117 are directed to conducting the financial transactions with a cash card (a method of payment). Where is Applicants' "sweeping the funds and an account sweep control module in claims 26-84 and 118-129? If Applicants' want the claims 85-117 in Group II examined with the claims 26-84 and 118-129 in Group I, it is suggested to add "maintaining an account at a financial institution, conducting the financial transactions with a cash card and sweeping the funds" into the claims in Group II to resolve this issue.

***Election/Restrictions***

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 26-84, and 118-129, drawn to maintaining an account at a financial institution and sweeping the funds and an account sweep control module classified in class 705, subclass 39.
  - II. Claims 85-117, drawn to conducting financial transactions with a cash card, classified in class 705, subclass 40.
  - III. Claims 130-157, drawn to providing an anonymous transaction, classified in class 705, subclass 42.
5. Inventions Group I, Group III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as

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claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Group I has separate utility such as maintaining an account at a financial institution and sweeping the funds and an account sweep control module. The subcombination group II has separate utility such as providing an anonymous transaction.

Inventions Group I and Group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group I has separate utility such as maintaining an account at a financial institution and sweeping funds represented by a direct deposit, and an account sweep control module. Group II has separate utility such as conducting financial transactions with a cash card.

Inventions Groups II and Group III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group II has separate utility such as Group II has separate utility such as conducting financial transactions with a cash card and Group III has separate utility such as providing an anonymous transaction. See MPEP § 806.05(d).

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination as indicated is proper.

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7. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II and Group III, the search for Group II is not required for Group I and Group III, and the search for Group III is not required for Group I and Group II, restriction for examination purposes as indicated is proper.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

9. Applicants' are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

10. Applicant is advised that the reply to this requirement to be completed must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

#### ***Inquiries***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday from 6:30 am -5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E. Colbert  
February 22, 2005